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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

CETIN KAYA

Serial No. 09/620,649 (TI-23686.1)

Filed July 20, 2000

For: INTEGRATED CIRCUIT HAVING INDEPENDENTLY FORMED ARRAY AND PERIPHERAL ISOLATIO DIELECTRICS

Art Unit 2822

Examiner D. Goodwin

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REPLY BRIEF

In reply to the Examiner's Answer, it is noted that the issue in this case is very simple and very clear. The issue is based solely on the definition of "invention" under 35 U.S.C. 102. This is precisely the issue in Pfaff v Wells, 525 U.S. 55, 119 S. Ct. 304, 142 L. Ed. 261, 48 USPQ2d 1641 (hereinafter "Pfaff")..

It is elementary that neither the examiner nor the Board has authority to overrule the U.S. Supreme Court. It is also clear that the above-noted Pfaff decision specifically relates to the definition of "invention" as it is applied under 35 U.S.C. 102, the basis of the rejection in this application. The fact that the above noted Pfaff decision also involves the issue of an

on-sale bar is totally irrelevant to the issue in this case. In order to arrive at its decision whether on not there was an on-sale bar, the Court first had to define the term "invention" as it applied to section 102 of 35 U.S.C. This the Court did. This definition of "invention" applies to 35 U.S.C. 102 in all cases and not only to on-sale bars as the examiner appears to imply if not state. The U.S. Supreme Court never limited its definition of "invention" under 35 U.S.C. 102 solely to on-sale bar situations and there was not basis for the Court to do so.

With regard to the question of diligence, it is clear from the record that appellants were diligent ab initio. At no time was there a material hiatus. The only problem was that the subject application was, according to the Patent and Trademark Office, erroneously filed a few days more than on year after filing of the provisional application. It follows from these facts that the hiatus from the abandonment of the provisional application and the filing of the subject application was only a few days. In addition diligence cannot be an issue in this case even if it could have been an issue (which it is not) since it was not previously raised. Furthermore, there was never any discontinuance of activity in filing the subject application as is evidenced by the record in the subject application.

The position taken as to the application of 37 C.F.R. 1.131 is also without merit. The C.F.R. cannot override 35 U.S.C. or the U.S. Supreme Court. To the extent that 37 C.F.R. 1.131 is in conflict with the Pfaff decision, the Pfaff decision is controlling. For that reason alone the arguments presented in the Examiner's Answer relative to 37 C.F.R. 1.131 are irrelevant to the issue in this case.

It is clear that the provisional application is evidence of conception, if not more, and this is established at least by the decision In re Costello, 717 F2d 1346, 1350, 219 USPQ 389,392 (Fed Cir. 1983). Since the provisional application is a basis to establish conception

(it also establishes that the invention was "ready for patenting"), it is ludicrous to state that there is no diligence when the hiatus from the abandonment of the provisional application to the filing of the subject application is a matter of a few days and it is clear from the record that a constant attempt was being made up to filing to perfect the filing of the application.

It is abundantly clear that the invention disclosed in the subject application was "ready for patenting" prior to the effective date of the Van Buskirk patent under the dictates of the Pfaff decision. The Pfaff decision overrides the C.F.R., the M.P.E.P and defines the meaning of "invention" under 35 U.S.C. 102. Only an act of Congress can override the present definition of "invention" as established by the Supreme Court.

In view of the above arguments and the arguments presented in the Brief on Appeal. Van Buskirk is not available as a reference under 35 U.S.C. 102(e) in this case in view of the definition of "invention" under 35 U.S.C 102 by the U.S. Supreme Court and, accordingly, the rejection is without merit. For the above reasons and the reasons presented in the Brief on Appeal, the final rejection should be reversed and the rejected claims allowed that justice be done in the premises.

Respectfully submitted,

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